



Paper No. 17

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**APR 06 2004**

In re Application of  
Tsuyoshi Yamamoto et al  
Application No. 09/873,206  
Filed: June 5, 2001  
Attorney Docket No. NIPP.0001

**OFFICE OF PETITIONS**  
:  
: DECISION ON PETITION  
: UNDER 37 CFR 1.78(a)(3)  
: AND UNDER 37 CFR 1.55(c)  
:

This is a decision on the petition under 37 CFR 1.78(a)(3) and the renewed petition under 37 CFR 1.55(c), filed March 16, 2004, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of a prior-filed PCT application, and under 35 U.S.C. § 119 for the benefit of a prior-filed foreign application.

The petitions are **Dismissed**.

As to the benefit claim under 37 CFR 1.78(a)(3):

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;<sup>1</sup>
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the

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<sup>1</sup> Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1).

In the Office letter mailed March 15, 2004, it stated that "the relationship between the instant application and the PCT application must also be stated; i.e., whether the instant nonprovisional application is a continuation, division, or continuation-in-part of the PCT application. This information should be provided in an amendment or an application data sheet.

As to the benefit claim under 37 CFR 1.55(c):

A petition for acceptance of a claim for foreign priority under 37 CFR 1.55(c) is only applicable to those applications filed on or after November 29, 2000. Further, the nonprovisional application must be filed within 12 months of the filing date of the foreign application. In addition, a petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority under 35 U.S.C. § 119(a)-(d) must be accompanied by:

- (1) the claim under 35 U.S.C. § 119(a)-(d) to the prior foreign application, unless previously submitted;<sup>2</sup>
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1).

In the amendment submitted with the instant petition, the foreign priority claim for benefits to Japanese Application No. 10-347299, filed December 7, 1998, should not be included in the amendment claiming priority under 35 U.S.C. § 120. The foreign application, Japanese No. 10-347299, filed December 7, 1998, is included in the declaration submitted with the instant application.

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<sup>2</sup> The claim must identify in the oath or declaration the foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by specifying the application number, country, and the filing date. Note also 37 CFR 1.63(c)(2).

Before the petitions can be granted, the above matters should be corrected.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                      Mail Stop PETITIONS  
                                 Commissioner for Patents  
                                 Post Office Box 1450  
                                 Alexandria, VA 22313-1450

By hand:                     Customer Window located at:  
  
                                 2011 South Clark Place  
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By fax:                        (703) 872-9306  
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Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-8859.



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Office of the Deputy Commissioner  
for Patent Examination Policy